

REMARKS

Claims 1-16 and 18-29 remain pending in the subject application. Claims 26 and 27 have been amended to correct minor typographical errors. Applicants respectfully request entry of the above amendment after final to put the claims in condition for allowance or otherwise present the claims in better form for consideration on appeal under 37 CFR 1.116(b)(2).

Applicants have considered all of the rejections raised in the Final Office Action of November 8, 2007, and respond fully below.

Rejections under 35 U.S.C. § 102(b)

USP 6,258,340

Claims 1-16 and 18-29 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by USP 6,258,340 (“Licha”). In order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference. Applicants respectfully traverse this rejection, since Licha does not disclose each and every element required by these claims.

Licha discloses various dyes and the use of near infrared radiation for *in vivo* diagnostic purposes. For instance, Licha states:

This invention relates to *an in-vivo diagnostic method* based on near infrared radiation (NIR radiation) that uses water-soluble dyes and their biomolecule adducts, each having specific photophysical and pharmaco-chemical properties, as a contrast medium for fluorescence and transillumination diagnostics in the NIR range, to new dyes and pharmaceuticals containing such dyes. (Emphasis provided.) (Column 1, lines 11-19.)

When applying the method according to the invention in *in-vivo* diagnosis, one or several substances of the general formula I is/are *administered to the tissues, for example, by intravenous injection*, then they are irradiated with light from the visible to the near infrared range of 650 to 1200 nm. Radiation that is not absorbed and fluorescence radiation are recorded separately or simultaneously, or against each other with a delay. A synthetic image is generated from the data obtained. (Emphasis provided.) (Column 8, lines 1-9.)

Licha teaches administering compounds to a tissue or an animal *in vivo*. Licha does not teach providing a *cytological sample in solution in a vessel* (see claim 1, line 3), which clearly refers to an *in vitro* process. Since the Examiner does not even address this element of claim 1, it is not clear where, or if, this element of claim 1 is taught in the Licha reference. The Examiner argues (last paragraph of p. 3) that “in the absence of Applicants’ better defining what method

steps are intended, these limitations are sufficiently broad to have been properly read on Licha's NIR diagnostic method". However, even if interpreted broadly, the recitation in claim 1 of "providing a cytological sample in solution in a vessel" is not taught or suggested by Licha. The Examiner has failed to point out where, or if, Licha teaches a *sample in solution* or that the solution is in a *vessel*. Thus, Applicants maintain that Licha does not teach or suggest several of the elements in line 3 of claim 1.

Further, Licha does not teach attaching a positive designator or a manipulation designator to the sample vessel depending on the outcome of the comparison with a criterion. The Examiner states that the claimed attachment of positive and manipulation designators are read on the steps of recording the synthetic image and comparison to certain parameters to obtain a diagnosis taught by Licha. Applicants respectfully submit that this interpretation is contrary to the teachings of the specification, in view of how the claims of the application are read. As discussed in the specification at p. 13, line 24 through p. 14, line 3, the designators can be physically or electronically attached to the sample vessel. Applicants maintain that Licha's recording of the image does not fall within this definition of a designator. In response, the Examiner has simply stated (p. 3, last paragraph) that "the Office has interpreted "positive designator" in its broadest context and believes it has been properly read on Licha". The Examiner has still failed to clarify how the Licha reference meets the "designator" element of claim 1. Further, Applicants respectfully remind the Examiner that claims must be "given their broadest reasonable interpretation consistent with the specification" (emphasis added, see MPEP §2111).

In addition to not teaching a designator at all, Licha further does not teach attaching a designator *after* the step of determining whether a result of the optical interrogation meets a criterion. Independent claim 1 recites that a positive designator is attached if the result meets the criterion and a manipulation designator is attached if the result does not meet the criterion. Clearly, the claim requires that the step of determining whether the result meets the criterion must occur before attaching a designator since the decision of which designator to attach is based on whether the results meet the criterion. The Examiner states that the steps of recording a synthetic image and comparison to certain parameters to obtain a diagnosis reads on the claimed attaching a positive designator and attaching a manipulation designator steps. However, nowhere does Licha teach that a step of determining whether a result meets a criterion occurs *before* a step of attaching a designator.

In further addition to not teaching a designator at all, Licha does not teach attaching a designator *to the vessel* (see claim 1, lines 6-9). For example, assuming *arguendo* that the Examiner believes that the tissues read on the claimed vessel, Licha still does not teach attaching a designator to the tissues. In fact, Licha does not teach that anything is attached to the tissues. Thus, Licha fails to teach several of the elements recited in lines 6-9 of claim 1.

Licha does not teach or suggest several of the elements of independent claim 1. For at least these reasons, Applicants respectfully submit that independent claim 1, along with the remaining claims which depend therefrom, are not anticipated by Licha, and respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 102(b) based on Licha.

EP 0 573 535

Claims 1-16 and 18-29 also stand rejected under 35 U.S.C. § 102(b), for allegedly being anticipated by EP 0 573 535 ("Rava"). In order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference. Applicants respectfully traverse this rejection, since Rava does not disclose each and every element required by these claims.

Rava is directed to systems and methods of performing spectral diagnostics to diagnose the tissue in front of a fiber. See, for example, Paragraph [0018]. Rava does not teach providing a *cytological sample in solution in a vessel* (see claim 1, line 3). Since the Examiner does not even address this element of claim 1, it is not clear where, or if, this element of claim 1 is taught in the Rava reference. The Examiner has failed to point out where Rava teaches a *sample in solution* or that the solution is in a *vessel*. Thus, Applicants submit that Rava does not teach or suggest several of the elements in line 3 of claim 1.

Rava does not teach attaching a positive designator or a manipulation designator to the sample vessel, depending on the outcome of the comparison with a criterion. The Examiner states that the claimed attachment of positive and manipulation designators may be read on the steps of recording the image and subsequent comparison to certain parameters to obtain a diagnosis taught by Rava. Applicants respectfully submit that this reading is contrary to the teachings of the specification, in view of how the claims of the application are read. As discussed above, the designators can be physically or electronically attached to the sample vessel. Applicants maintain that Rava's recording of the image does not fall within this definition of a designator. In response, the Examiner has simply stated (p. 4, first full paragraph)

that “the Office maintains these limitations are sufficiently broad to be properly read on Rava as described in the above rejection”. The Examiner has still failed to clarify how the Rava reference meets the “designator” element of claim 1. Further, Applicants respectfully remind the Examiner that claims must be “given their broadest *reasonable* interpretation *consistent with the specification*” (emphasis added, see MPEP §2111).

In addition to not teaching a designator at all, Rava further does not teach attaching a designator *after* the step of determining whether a result of the optical interrogation meets a criterion. Independent claim 1 recites that a positive designator is attached if the result meets the criterion and a manipulation designator is attached if the result does not meet the criterion. Clearly, the claim requires that the step of determining whether the result meets the criterion must occur before attaching a designator since the decision of which designator to attach is based on whether the results meet the criterion. The Examiner states that the steps of recording an image and *subsequent* comparison to certain parameters to obtain a diagnosis reads on the claimed attaching a positive designator and attaching a manipulation designator steps. However, nowhere does Rava teach that a step of determining whether a result meets a criterion occurs *before* a step of attaching a designator.

The Examiner argues (in the first full paragraph of p. 4) that the Applicants state that Rava “does not teach the claimed attaching a positive or manipulation designator *to the sample*” (emphasis added) and that “the Office maintains these limitations are sufficiently broad to be properly read on Rava as described in the above rejection.” Applicants respectfully submit that the Examiner has mis-read the Applicants’ arguments and the claims since Applicants stated that Rava does not teach attaching a positive designator or a manipulation designator *to the sample vessel*. In addition, the rejection alleges that “attaching a positive designator *to the sample...*” (emphasis added) reads on Rava’s steps of recording the image and subsequent comparison. Thus, the rejection does not even address the recitation of attaching a positive designator and/or a manipulation designator *to the sample vessel*. As discussed above, Rava does not teach a designator at all and further does not teach attaching a designator to the vessel.

Thus, Rava does not teach or suggest several of the elements of independent claim 1. For at least these reasons, Applicants respectfully submit that independent claim 1, along with the remaining claims which depend therefrom, are not anticipated by Rava, and respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 102(b) based on Rava.

USP 5,168,066

Claims 1-16 and 18-29 stand further rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by USP 5,168,066 (“Zahniser”). In order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference. Applicants respectfully traverse this rejection, since Zahniser does not disclose each and every element required by these claims.

Zahniser is directed to methods of staining and imaging cells smeared on a slide. The cells of Zahniser are not *in solution in a vessel*. Thus, Zahniser does not teach or suggest several of the elements in line 3 of claim 1, which recites “providing a cytological sample in solution in a vessel”. The Examiner argues (second full paragraph on p. 4) that “vessel” is sufficiently broad to be properly read on the microscope slide taught by Zahniser. However, nowhere does the Examiner address the recitation of the sample being *in solution* in a vessel.

Further, Zahniser does not teach attaching a positive designator to the sample vessel or attaching a manipulation designator to the sample vessel. The Examiner states that the claimed attachment of positive and manipulation designators may be read on the steps of recording the image and comparison to certain parameters to obtain a diagnosis taught by Zahniser. Applicants respectfully submit that this reading is contrary to the teachings of the specification, in view of how the claims of the application are read. As discussed above, the designators can be physically or electronically attached to the sample vessel. Zahniser’s recording of the image does not fall within this definition of a designator.

In addition to not teaching a designator at all, Zahniser further does not teach attaching a designator *after* the step of determining whether a result of the optical interrogation meets a criterion. Independent claim 1 recites that a positive designator is attached if the result meets the criterion and a manipulation designator is attached if the result does not meet the criterion. Clearly, the claim requires that the step of determining whether the result meets the criterion must occur before attaching a designator since the decision of which designator to attach is based on whether the results meet the criterion. The Examiner states that the steps of recording an image and comparison to certain parameters to obtain a diagnosis reads on the claimed attaching a positive designator and attaching a manipulation designator steps. However, nowhere does Zahniser teach that a step of determining whether a result meets a criterion occurs *before* a step of attaching a designator.

In further addition to not teaching a designator at all, Zahniser does not teach attaching a designator to the *sample vessel*. The Examiner indicates (second full paragraph of p. 4) that the microscope slide taught by Zahniser reads on the claimed vessel. Nowhere does Zahniser teach that a designator is attached to the microscope slide. In fact, Zahniser does not teach attaching anything to the microscope slide.

Thus, Zahniser does not teach or suggest several of the elements of independent claim 1. For at least these reasons, Applicants respectfully submit that independent claim 1, along with the remaining claims which depend therefrom, are not anticipated by Zahniser, and respectfully request reconsideration and withdrawal of the claim rejections under 35 U.S.C. § 102(b) based on Zahniser.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully submit that the pending claims are now allowable over the cited references. Applicants invite the Examiner to call the undersigned if any remaining issue(s) can be resolved through a telephonic discussion.

Respectfully submitted,
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